

## REMARKS

This amendment is filed in response to an office action mailed March 24, 2004 in which the Examiner (a) withdrew from consideration claims 58-67 and (b) rejected claims 1-57 under 35 U.S.C. §102(e) as unpatentable over U.S. patent serial number 6,108,688 ("Nielsen"). These actions will be addressed in turn. Claim 68 was neither rejected nor withdrawn.

The Examiner issued a five way telephone restriction, dividing the claims into the following groups:

Group	Claims	Classification	Explanation
I	1-57	709/207	"system for obtaining responses to a message using contact numbers"
II	58	709/206	"response message system utilizing and email system and multiple interfaces"
III	59	709/224	"response message system utilizing the internet"
IV	62-64	709/206	"response message system utilizing voicemail"
V	65-67	709/225	"resposne [sic] message system utilizing validating customers"

Manual of Patent Examining Procedure ("MPEP") §803 sets forth the requirements for restriction in general terms:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is required

MPEP §802.01 provides the definitions of independent and distinct.

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect .... The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

MPEP §812.01 further makes clear that if a restriction is proper and telephone restriction practice is utilized, the restriction itself must be incorporated into the body of the first office action. MPEP §816 states that the reasons that the Examiner believes that each group of claims is distinct from each other must be set forth in this restriction. MPEP §808.02 states that the reasons that the Examiner believes that there would be a serious burden on the Examiner must also be explained.

In the present case, the Examiner (a) failed to file a formal restriction (only providing an interview summary referring to a restriction), (b) has provided no explanation of why the Examiner believes the claims to be independent or distinct, and (c) provided little explanation of why the Examiner believes that examining all of the claims would be a serious burden under the statute.

Given that all of the claims could read on a single messaging system, the claims groups cannot be independent. The question is then whether the claim groups are distinct, that is to say whether each claim group is patentable over each other claim group

treating each other claim group as prior art. Without a showing by the Examiner that such is the case, a restriction is not proper.

Second, the Examiner must show that a serious burden exists. A *prima facie* case for such a burden can be shown by establishing separate classification or separate status in the art. The Examiner did not, however, indicate the basis for her holding, providing only cryptic comments. The five groups were classified into four subclasses of class 709; thus, separate classification cannot be the basis for a serious burden. It is also significant that four of the five descriptions of the five groups pertain to group I:

Group I (using contact numbers): claim 1;

Group 2 (utilizing ... email system and multiple interfaces): claims 6, 47;

Group 3 (utilizing internet): claim 38; and

Group 4 (utilizing voicemail): claim 38.

Moreover, only one of the three claims in group V actually includes a validation step. Thus, the Examiner's search for group I should cover virtually all of the subject matter covered by all of the five groups, regardless of the group in which each claim is classified. For all of these reasons, the applicant traverses the Examiner's restriction requirement and respectfully requests that it be withdrawn.

The Examiner rejected claims 1-57 under 35 U.S.C. §102(e) as unpatentable over Nielsen. Each of the independent claims (namely claims 1, 44, 45, 46, and 47) rejected by the Examiner includes a step or a limitation relating to ranking associated contact numbers. Claim 1 includes "prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest". Claim 44 includes "receiving a message and a ranked set of associated contact

numbers from the sender”. Claim 45 includes “means for prompting a user to rank the associated contact numbers relating to the recipient identified by the sender from highest to lowest”. Claim 46 includes “prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest”. Claim 47 includes “wherein said processor causes a user to be prompted to rank the associated contact numbers relating to the identified recipient from highest to lowest”.

Nielsen is a “system for reminding a sender of an email if recipient of the email does not respond by a selected time set by the sender”. It “provides the sender of an e-mail message with the capability of automatically generating a warning message on the sender’s system if the recipient of the message has not opened the message by a time specified by the sender.” Col. 1, lines 54-58. Nielsen relates purely to e-mail (and therefore to messages sent by e-mail), although it does provide mention the possibility of using other means of communication such as telephone calls and pages *to notify the sender* that a message has not been delivered. Col. 2, lines 28-30; col. 4, lines 8-13; col. 8, lines 8-17. Contrastingly, the claimed invention is not limited to e-mail, but encompasses messages of many varieties sent through many channels of communication, including e-mail (claim 6), paging (claim 7), automated telephone call (claim 8), and facsimile (claim 10).

Although Nielsen does mention an “optional ... provision to enable the sender to have the original message resent to the recipients through some other delivery mechanism, for example a fax modem, the telephone, or some other means”, col. 8, lines 23-28, Nielsen does not disclose or suggest storing facsimile or telephone numbers and

associating them with the recipients. Instead, Nielsen simply suggests a dialog box for entering such numbers at runtime.

It is reasonable to assume that Nielsen provides means for storing the e-mail address of the recipient of an e-mail message. An “associated contact number” is defined as follows in the specification:

An identifier relating to a particular message recipient used to address a message to that recipient, such as a telephone, pager, or facsimile number or an e-mail address. In a preferred embodiment, the associated contact number includes both the identifier itself (such as a telephone number or an e-mail address) and a designation of the type of the identifier (such as telephone number or e-mail).

An e-mail address of a message recipient is thus an associated contact number.

Telephone, pager, and other contact numbers relating to the message sender are not associated contact numbers. Nielsen does not disclose or suggest the existence of multiple associated contact numbers with respect to a single message recipient.

Moreover, Nielsen does not disclose or suggest the concept of prompting a user to rank multiple associated contact numbers or receiving a ranked list of such ranked associated contact numbers from the user. Thus, independent claims 1 and 44-47, and all of the claims that depend from them, are patentable over the prior art of record.

With respect to claims 2 and 3, the Examiner cited col. 1, lines 45-47, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, these rejections are additionally invalid for this reason.

With respect to claim 7, as discussed above, the sender never sends a message by page according to Nielsen. Rather, in an alternative embodiment the sender receives notification of message failure by e-mail.

With respect to claims 8 and 50, as discussed above, the sender never sends a message by automated telephone call according to Nielsen. Rather, in an alternative embodiment the sender receives notification of message failure by automated telephone call.

With respect to claim 9, claim 9 relates to a situation in which a call has been connected but no response has been received subsequently. Column 4, lines 20-31 of Nielsen, on the other hand relates to a situation in which an e-mail message has not been received. These situations are simply not analogous. An analogous situation in the e-mail context would be if the e-mail message had been received by the recipient (and a return receipt had been received by the sender) but no substantive reply to the e-mail had been received by the sender by a certain date. Nielsen does not disclose or suggest any such capability.

With respect to claims 10 and 49, the Examiner cited col. 1, lines 45-48, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, these rejections are additionally invalid for this reason.

With respect to claim 13, col. 4, lines 32-65 of Nielsen does not disclose or suggest forwarding two or more responses in different iterations of step (h) together. Rather, this section of Nielsen discloses the capability of forwarding two or more responses from one person, but not together, or limiting the number of responses. According to Nielsen's logic, as each e-mail message is delivered, a response will be forwarded.

With respect to claims 14-17, Nielsen does not suggest or disclose a “composite report”. The Examiner did not identify a “composite report” in the cited passage of Nielsen.

With respect to claim 18, Nielsen does not suggest or disclose *inter alia* “prompting the current recipient to indicate whether to send the current recipient’s response to the other recipients of the sender’s message”. The Examiner has not identified any “other recipients” in any of the cited passages of Nielsen.

With respect to claim 19, Nielsen does not disclose or suggest a plurality of associated contact numbers or provide for any ranking of associated contact numbers, as discussed above. Moreover, the Examiner cited col. 1, lines 44-51, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 20, Nielsen does not disclose or suggest a plurality of associated contact numbers or provide for any ranking of associated contact numbers, as discussed above. Moreover, the recipient is not prompted in the cited passage of Nielsen, the sender is.

With respect to claim 21, Nielsen does not disclose or suggest a plurality of associated contact numbers or provide for any ranking of associated contact numbers, as discussed above. Moreover, the cited passages of Nielsen do not relate to a user other than the sender or the recipient. Furthermore, , the Examiner cited col. 1, lines 44-51, which relates to prior art and not to Nielsen. A reference cannot be combined with prior

art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 22, the Examiner cited col. 1, lines 44-51, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 23, Nielsen does not disclose or suggest a plurality of associated contact numbers or provide for any ranking of associated contact numbers, as discussed above. Moreover, the Examiner cited col. 1, lines 44-51, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 24, while Nielsen does disclose a data field that relates to time, that field is used for uniquely matching messages, col. 3, lines 36-59, not as a condition for selecting a ranking of associated contact numbers.

With respect to claim 25, while Nielsen does disclose a data field relating to dates, this data field is used for determining when to send the sender a non-delivery warning, col. 3, lines 8-26, not as a condition for selecting a ranking of associated contact numbers.

With respect to claim 26, the cited section of Nielsen discloses a checkbox of potential *recipients* for determining the recipients of messages, col. 4, lines 32-52, not the use of the identity of the sender as a condition for selecting a ranking of associated contact numbers.



With respect to claim 27, the cited section of Nielsen discloses the use of a subject data field for uniquely matching messages, col. 3, line 36 to col. 4 line 13, not as a condition for selecting a ranking of associated contact numbers.

With respect to claim 28, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 29, as discussed above, Nielsen does not suggest or disclose the use of multiple associated contact numbers. Accordingly, it does not disclose or suggest “prompting a user to provide a commencement time for at least one associated contact number, wherein if the performance of an iteration of step (d) occurs prior to the commencement time of an associated contact number, the associated contact number is not utilized in the performance of the current iteration of step (d)”. Moreover, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 30, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 31, Nielsen does not suggest or disclose that “the predetermined amount of time is equal to zero seconds” Moreover, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be

combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 32, Nielsen does not suggest or disclose that “the predetermined amount of time exceeds zero seconds” Moreover, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 33, Nielsen does not suggest or disclose that “the predetermined amount of time depends on the channel of communication used for sending the message in the current iteration of step (d)” Moreover, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claim 34, Nielsen does not suggest or disclose that “prompting a user to provide an amount of time, wherein ... the predetermined amount of time in step (f) is equal to the amount of time provided by the user ....” Moreover, the Examiner cited col. 1, lines 11-25, which relates to prior art and not to Nielsen. A reference cannot be combined with prior art cited in that reference in an *anticipation* rejection. Hence, this rejection is additionally invalid for this reason.

With respect to claims 35-37 and 39, Nielsen does not disclose or suggest “converting a verbal message provided by the sender in response to step (a) into textual form”. Column 3, lines 18-26 relate to a description of a user interface for use by a sender in selecting e-mail message non-delivery warning options. This section of Nielsen

discloses the use of “voice-activated commands” to select such options. Voice-activated commands are not equivalent to converting verbal messages to text, which typically poses much greater difficulties.

With respect to claim 38, Nielsen does not suggest or disclose “wherein step (a) is performed over the Web”. Nielsen simply does not suggest or disclose “prompting the sender to provide a ... type of data to be collected”. Nielsen does not suggest or disclose “prompting the sender to provide a message to be provided if the message is sent by telephone call and the telephone call is answered by a voicemail system”. Nielsen does not suggest or disclose “using automatic speech recognition if the message is sent to a telephone number”. Voice-activated commands are not equivalent to automatic speech recognition. Nielsen simply does not suggest or disclose “in the case of a message being sent to an associated contact number that includes a telephone extension, automatically dialing both the telephone number and the telephone extension”.

With respect to claim 40, Nielsen does not disclose or suggest wherein if the transmission of a message using an associated contact number is not successful in step (d), the message is retransmitted to the same associated contact number until the message is successfully transmitted to the associated contact number or until a predetermined number of transmissions have been unsuccessful. Nielsen always initially sends a message by e-mail. E.g., col. 2, lines 4-30. Because e-mail generally arrives relatively swiftly or never regardless of the number of times that it is sent, there is no apparent reason to resend e-mail messages multiple times to the same e-mail address as a matter of course to ensure that they are received. (Resending e-mail messages to obtain responses is another matter altogether.) Moreover, Nielsen does not suggest or disclose resending

e-mail messages to recipients. Instead, Nielsen suggests notifying the sender of the message failure or possibly resending the message using an alternate means of communication (with any contact numbers being supplied at runtime).

With respect to claim 41, Nielsen does not suggest or disclose prompting the recipient to indicate the recipient's response is urgent wherein, if the recipient indicates that the response is urgent, the response is sent to the sender within a predetermined amount of time. The cited passage of Nielsen does not provide any additional capabilities to the user of Nielsen's system; instead, it relates to the method by which Nielsen's system interfaces with prior art e-mail systems to provide previously stated capabilities. Although Nielsen does provide notification of non-delivery by a stated time, col. 5, lines 8-23, Nielsen does not suggest or disclose any means for speeding up delivery of messages when the messages are urgent.

With respect to claim 42, Nielsen does not suggest or disclose prompting a sender to contact an operator, wherein the operator has access to data relating to the sender's message. The cited section of Nielsen refers to sending the sender a message including data relating to the sender's message but does not make clear that it is an operator that is sending the message.

With respect to claim 43, Nielsen does not suggest or disclose a message provided by a sender wherein the message comprises a plurality of questions and the recipient is prompted to provide an answer to each question in the sender's message. The cited passage of Nielsen discloses questions that are not part of the sender's message and are not provided to the recipient. Nielsen does not disclose prompting the recipient with respect to such questions.

Claim 68 was neither rejected nor restricted.

For the above reasons, the applicant believes that the restriction entered by the Examiner should be withdrawn, that claims 1-57 and 68 are allowable over the prior art of record, and that claims 1-68 are allowable and requests that a timely Notice of Allowance be issued.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Ethan Civan", is written over a horizontal line.

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